

REMARKS

The above amendment and these remarks are responsive to the Office action of 1/15/2003.

Drawings

Objection has been made to the drawings (1) for not mentioning reference number 332 in the specification, and (2) for not showing in the drawings reference sign 224. The Examiner requires that a corrected drawings or a proposed drawing correction be presented in this response.

With respect to reference number 332, such is mentioned in the specification at page 33, line 4. Applicants have also amended the specification at page 22 to refer to this element.

With respect to reference sign 224, the transition/transformation phase illustrated in Figure 3C should be designated 224, not 222 as is erroneously indicated in Figure 3C but properly referenced at page 9,

line 17.

Consequently, applicants propose amending Figure 3C as marked up on the attached, corrected drawing to replace reference numeral 222 with 224 and, subject to the approval of the Examiner, will before or upon allowance of claims submit formal drawings for entry in the case with that correction.

Specification

The disclosure has been objected to for inconsistent use of the reference number 222, and for lack of a brief description of Figure 6. Applicants have amended the specification to correct these informalities.

35 U.S.C. 101

Claims 1-17 have been rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. Apparently, this rejection has also been applied to claims 20 and 21 [Office action, paragraph 5, sections (B) and (C)].

As suggested by the Examiner, applicants have amended independent claims 1, 4, 6, 8, 10, 12, 16-17, and 20 to expressly state in the body of the claims the use of technology such as a computer or a computer database.

As amended, applicants request the rejection of claims 1-17 (and 20-21) under 35 U.S.C. 101 be withdrawn.

35 U.S.C. 112

The claim 13 limitation "said developing step" in line 1 has been objected to. Applicants believe that the developing step at claim 12, line 3 provides the antecedent basis for "said developing step". Claim 12, line 3 states: "during a proposal contextual phase, developing..." [Emphasis added.]

Claims 1-17 have been rejected under 35 U.S.C. 112, second paragraph, for omitted structural cooperative relationships. Applicants have amended the independent claims 1, 4, 6, 8, 10, 12, 16-17 to positively recite structures, including computer or computer database, which form the basis for cooperative relationships between the

functional elements of claims 1-17.

Applicants request that the rejection of claims 1-17 under 35 U.S.C. 112 be withdrawn.

35 U.S.C. 102

Claims 1-7, 10-17, and 22-26 have been rejected under 35 U.S.C. 102(b) over Davis et al. ("The Information System Consultant's Handbook: Systems Analysis and Design", CRC Press).

Applicants invention relates to a system and method for systematically defining and implementing a measurement program for an information technology (I/T) organization based on primitive and/or computed metrics identified and selected according to a two step process involving the generation of first and second draft models.

Davis is a handbook for systems analysis and design which is a general survey of principles, and does not teach applicants' specific two step process.

Claims 1, 4, 6, 10, 12, 17, 22-26 have been amended to clarify this distinction with respect to Davis. Claims 2-3, 5, 7, 11, 13-16 depend from amended claims and distinguish Davis on that basis.

Applicants request that claims 1-7, 10-17, and 22-26 be allowed.

35 U.S.C. 103

Claims 8-9, 18-21, and 27-28 have been rejected under 35 U.S.C. 103(a) over Davis in view of Nagai et al. (US 2001/0025247 A1).

With respect to claims 8, 9, 18, 19, and 27, the independent claims have been amended to clarify that applicants' invention includes building first and second draft model with metrics selected by prioritizing based on number of behaviors satisfied and number of related metrics, which is not taught by either Davis or Nagai.

With respect to claims 20, 21 and 28, applicants traverse, and argue that the Examiner has not established a

prima facie case of obviousness, which requires that the Examiner provides

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The fourth element of the prima facie case, the suggestion to combine, must come from the prior art, and the suggested combination must not require substantial reconstruction or redesign of the references to arrive at the claimed invention.

With respect to claims 20 and 28 substantial reconstruction is required. That is, neither Davis or Nagai teach the claimed method for building the second draft model based on number of behaviors satisfied or number of related measures, as those metrics are defined by applicants' specification. Davis provides a general discussion for

building any system. Nagai does not discuss the concept of behaviors (as distinguished from objectives, which he does discuss), nor do the metrics of either Davis or Nagai include numbers of measures -- this being a quantitatively determined metric as distinguished from Nagai's subjective objectives.

Applicants request that claims 8-9, 18-21, and 27-28 be allowed.

SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-28.

If, in the opinion of the Examiner, a telephone conversation with applicant(s) attorney could possibly facilitate prosecution of the case, he may be reached at the number noted below.

Sincerely,

S. M. Jordan, et al.

By


Shelley M Beckstrand
Reg. No. 24,886

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Shelley M Beckstrand, P.C.
Attorney at Law
314 Main Street
Owego, NY 13827

Phone: (607) 687-9913
Fax: (607) 687-7848